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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,683	04/21/2000	Lawrence Xavier Webb, M.D.	F. 003	6497

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EXAMINER

MANTIS MERCADER, ELENI M

ART UNIT

PAPER NUMBER

3737

DATE MAILED: 07/30/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/553,683

Applicant(s)

WEBB, M.D., LAWRENCE XAVIER

Examiner

Eleni Mantis Mercader

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/19/2003 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 30-38, 41-43, 47-49 and 53-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller'762, of record in view of Krupnick'035, also of record.

Muller'762 teach all the features of the instant invention including a drape with radio-opaque grid lines 53 which are vertical and horizontal (see col. 6, lines 18-36) which are uniquely identifiable by letters and numbers as indicated by Figure 1. Adhesive is provided on a major portion of the drape (see col. 5, lines 15-18). Muller'762 does not teach the use of imaging technology wherein a pattern is obtained corresponding to the radio-opaque labels on the surgical drape.

In the same field of endeavor, Krupnick'035 teaches the use of imaging technology wherein a pattern is obtained corresponding to the radio-opaque labels on the surgical drape (see

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Figure 4 and see col. 5, lines 5-16). Krupnick'035 also teaches a cutout through the grid lines to effectuate a biopsy (see Figure 2 and see col. 5, lines 17-31).

It would have been obvious to one skilled in the art at the time that the invention was made to have modified Muller'762 to incorporate the teachings of Krupnick'035 in order to utilize imaging to more correctly identify the area for biopsy (motivation to combine provided by Krupnick'035 in col. 5, lines 15-16, reciting that imaging technology through the radio-opaque flexible substrate expedites localization of the area of interest).

4. Claims 39-40, 44-46, 50-52 and 62-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller'762 in view of Krupnick'035 and Mosby'985, all of record.

Muller'762 in view of Krupnick'035 teach all the features of the instant invention as set forth in paragraph 3 above, except for the use of radio-opaque circles and utilization of pliable material for use on breast procedures or on body parts resembling cylindrical or conical configurations such as a finger.

Mosby'985 teaches the use of radio-opaque circles and utilization of pliable material for use on breast procedures or on body parts resembling cylindrical or conical configurations such as a finger (see col. 5, lines 7-12; col. 6, lines 38-47 and col. 7, lines 1-10).

It would have been obvious to one skilled in the art at the time that the invention was made to have modified Muller'762 in view of Krupnick'035 to incorporate the teaching of Mosby'985 when using the drape during biopsy procedures of areas such as the breast or the finger to more readily localize the area of interest for biopsy using circular radio-opaque indications.

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Allowable Subject Matter

5. Claims 28 and 29 are allowed.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cosman et al.'680 teach a drape with imaging visible markers.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni Mantis Mercader whose telephone number is 703 308-0899. The examiner can normally be reached on Mon. - Fri., 8:00 a.m.-6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on 703 308-3256. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305-3590 for regular communications and 703 308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0858.



Eleni Mantis Mercader
Patent Examiner
Art Unit 3737

EMM
July 28, 2003